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REMARKS

Claims 1-4 and 6-44 are pending. Claims 1-3, 6-8, and 11 have been amended, claim 5 has been canceled, and new claims 19-44 have been added to recite additional features of Applicant's invention. In addition, a Proposed Amendment to the Drawings has been submitted with this paper to correct a typographical error in Figure 4.

Reconsideration of the application is respectfully requested for the following reasons.

In the Office Action, the Examiner rejected claims 1, 2, 6 and 11 under 35 U.S.C. §102(e) for being anticipated by the Alanara patent, and claims 3, 5, 7, 8, 10, 12, 14-16, and 18 were rejected under 35 U.S.C. §103(a) for being obvious in view of the Alanara patent. Applicant traverses these rejections for the following reasons.

Claim 1 recites a method for backing up user data in a communication system. This method includes transmitting user data of a first mobile terminal for storage in a base station, transmitting a phone number of the first mobile terminal to the base station with the user data, storing the user data in the base station using the transmitted phone number as an address, and downloading the user data stored in the base station to a second mobile terminal.

The Alanara patent discloses a method for backing up phone numbers and other user information stored in a mobile phone. This method involves transmitting the user information from the phone to a base station, storing the information in a short code memory, and then downloading that information from the base station memory to either the same phone or a new phone acquired by the user.

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In order to anticipate claim 1, the Alanara patent must disclose <u>every</u> <u>feature</u> recited in that claim, either explicitly or inherently. *In re Schreiber*, 44 USPQ.2d 1429, 1431 (Fed. Cir. 1997).

The Alanara patent fails to disclose at least two steps added by amendment to claim 1. First, claim 1 recites transmitting user data of a first mobile terminal for storage in a base station, and then <u>transmitting a phone number of the first mobile terminal to the base station with the user data</u>. Second, claim 1 recites <u>storing the user data in the base station using the transmitted phone number as an address</u>. The Examiner acknowledged that the Alanara patent does not disclose these features in connection with the remarks made with respect to claim 5 in the Office Action.

In spite of this deficiency, the Examiner took Official Notice that the above-underlined steps of claim 1, i.e., that these steps were well known at the time the claimed invention was made and furthermore it would have been obvious to one of ordinary skill in the art to modify the Alanara patent to include these steps at the time the claimed invention was made. Applicant submits that it is improper to take Official Notice for the following reasons.

MPEP §2144.03 sets forth the conditions under which it is proper for an examiner to take Official Notice of features recited in a claim:

> Official notice unsupported by documentary evidence should <u>only</u> be taken . . . where the facts asserted to be well-known, or to be common knowledge in the art are <u>capable of instant and unquestionable demonstration as being well-known</u>. (Emphasis added).

This MPEP section further provides that if the patent applicant traverses an allegation that claimed features are well known, the patent examiner should <u>cite a reference</u> in support of his

or her position. If such a reference cannot be found, the rejection should be withdrawn as a matter of law. See *In re Thrift*, 63 USPQ.2d 2002, 2006 (Fed. Cir. 2002).

Applicant respectfully submits that the test for taking Official Notice of steps (b) and (c) in claim 1 has not been satisfied. Step (b) recites "transmitting a phone number of the first mobile terminal to the base station with the user data." The Alanara patent does not teach or suggest these features. Nor were these features "capable of instant and unquestionable demonstration as being well known" to one of ordinary skill in the art at the time the claimed invention, i.e., it was not well known to transmit a phone number with user data for purposes of backing up the user data in a mobile terminal.

Step (c) recites "storing the user data in the base station using the transmitted phone number as an address." The Alanara patent does not teach or suggest these features. Nor were these features "capable of instant and unquestionable demonstration as being well known" to one of ordinary skill in the art at the time the claimed invention, i.e., it was not well known to store user data transmitted from a mobile terminal in a base station using the phone number of the mobile terminal as an address.

Applicants further challenge the Examiner to produce a reference to show that steps (b) and (c) were well known at the time the claimed invention was made when taken in combination with steps (a) and (d). Under the provisions of MPEP §2144.03 and the Federal Circuit's *Thrift* case, if such a reference cannot be produced it is respectfully submitted that the rejection is improper as a matter of law and should therefore be withdrawn on grounds that it was formulated as a result of hindsight, i.e., picking and choosing features from Applicant's

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specification and then combining them with Alanara without any objective teaching or

suggestion for doing so. The Board of Patent Appeals and the Federal Circuit both agree that

this practice is impermissible for purposes of rejecting a claim under 35 U.S.C. §103(a).

Incidentally, in the Office Action the Examiner acknowledged that the user data

transmitted from the mobile terminal of Alanara must inherently be stored in association with

information identifying the mobile terminal. Assuming *arguendo* that this is true, Applicant points

out that neither Alanara nor any other reference of record teaches or suggests the affirmative

steps of transmitting a phone number of the mobile terminal with the user data transmitted to

the base station and then storing that user data in the base station based on the transmitted

mobile phone number, whether those references are taken alone or in combination.

Claim 3 recites that step (a) of claim 1 includes "automatically ending radio connection

between the base station and the first mobile terminal after transmitting/receiving mutual

complete commands if the base station receives the user data from the first mobile terminal and

stores them therein." (Emphasis added). In the Office Action, the Examiner attempted to take

Official Notice of these features. Applicant submits, however, that these features were not

"capable of instant and unquestionable demonstration as being well known" to one of ordinary

skill in the art at the time the claimed invention, e.g., neither Alanara nor any other reference of

record teaches or suggests automatically ending a connection between a base station and a new

terminal once the base station receives and stores the user data from the first mobile terminal.

Claim 7 recites that step (d) of claim 1 includes "automatically ending connection

between the base station and the second mobile terminal after transmitting/receiving mutual

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complete commands <u>if the second mobile terminal receives and stores the user data from the base station.</u>" (Emphasis added). In the Office Action, the Examiner attempted to take Official Notice of these features. Applicant submits, however, that these features were not "capable of instant and unquestionable demonstration as being well known" to one of ordinary skill in the art at the time the claimed invention, e.g., neither Alanara nor any other reference of record teaches or suggests automatically ending a connection between a base station and a new terminal once the new terminal receives user data from the base station.

Claim 8 recites that step (d) includes "clearing the user data transmitted from the base station to the second mobile terminal if connection between the base station and the second mobile terminal is ended." In the Office Action, the Examiner attempted to take Official Notice of these features. Applicant submits, however, that these features were not "capable of instant and unquestionable demonstration as being well known" to one of ordinary skill in the art at the time the claimed invention, e.g., neither Alanara nor any other reference of record teaches or suggests clearing the user data transmitted from the base station to the second mobile terminal if connection between the base station and the second mobile terminal is ended.

Claim 10 recites that the user data is downloaded to the second mobile terminal "using a phone number corresponding to the user data to be downloaded as an address." The Alanara patent does not teach or suggest these features, nor were they capable of instant and unquestionable demonstration as being well known in the art at the time the claimed invention was made.

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Claim 11 recites: "transmitting a phone number of the first mobile terminal to the base station with the user data; storing the user data in the base station using the transmitted phone number as an address." These steps are not taught or suggested in Haynes, nor were they known in the art at the time the claimed invention was made.

The Examiner rejected claims 4, 9, 13, and 17 under 35 U.S.C. §103(a) for being obvious in view of a combination formed between the Alanara and Haynes patents. Applicant traverses this rejection for the following reasons.

Claims 4 and 9 depend from claim 1. In order to render these claims obvious, the Haynes patent must therefore teach or suggest the features of claim 1 missing from the Alanara patent. The Haynes patent was cited for its disclosure of programming the memory of new phones. The Haynes patent, however, does not teach or suggest steps (b) and (c) recited in claim 1. Any combination formed between Alanara and Haynes would therefore also necessarily omit these steps.

Claims 13 and 17 depend from claim 11. In order to render these claims obvious, the Haynes patent must therefore teach or suggest the features of claim 11 missing from the Alanara patent. The Haynes patent was cited for its disclosure of programming the memory of new phones. The Haynes patent, however, does not teach or suggest the steps of claim 11 missing from the Alanara. Thus, any combination formed between Alanara and Haynes would also necessarily omit these steps. Applicant therefore submits that claims 13 and 17 are allowable over an Alanara-Haynes combination at least by virtue of their dependency from claim 11.

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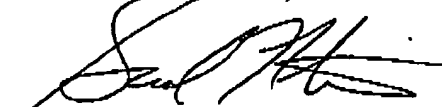Serial No. 09/656,025   Docket No. K-215

New claims 19-44 recite many of the features which patentably distinguish claims 1 and 11 or one of their dependent claims from the Alanara and Haynes patents. It is therefore submitted these new claims are also allowable.

Reconsideration and withdrawal of all the rejections and objections made by the Examiner is hereby respectfully requested.

In view of the foregoing amendments and remarks, it is respectfully submitted that the application is in condition for allowance. If the Examiner believes that any additional changes would place the application in better condition for allowance, the Examiner is invited to contact the undersigned attorney, <u>Samuel W. Ntiros</u>, at the telephone number listed below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this, concurrent and future replies, including extension of time fees, to Deposit Account 16-0607 and please credit any excess fees to such deposit account.

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Respectfully submitted,
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